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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/925,270	08/09/2001	Thomas D. Petite	081607-1170	5549

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EXAMINER	
HYUN, SOON D	

ART UNIT	PAPER NUMBER
2616	

DATE MAILED: 05/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/925,270	PETITE ET AL.	
	Examiner	Art Unit	
	Soon D. Hyun	2616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 December 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4,6-10 and 13-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4,6,8-10,13-17 and 19-21* is/are rejected.

7)☒ Claim(s) *7,18 and 22-24* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *12/18 and 12/28/06*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The cross-reference to related applications on the page 1 of the specification should be updated, i.e., Patent No., if issued or current status, if abandoned.

Claim Objections

2. Claims 1-4, 6, 13, and 22 are objected to because of the following informalities:

The limitations "adapted for", "configured to" or "configured for " recited in the claims should be deleted to make the claim positive under MPEP 2106, page 2100-8. Appropriate correction is required.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29

USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-4, 6, 8-10, 13-17, and 19-21 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 7 and 12 of copending Application No. 09/925,269. Although the conflicting claims are not identical, they are not patentably distinct from each other because "A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). " ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

Moreover, omission of a reference element whose is not needed would be obvious tone of ordinary skill in the art. It well settled that the omission of an element and its functions is an obvious expedient if the remaining elements perform the same function as before168 USPQ 375 (Bd..App. 1969). In re Karlson, 163 USPQ 184 (CCPA 1963). Also note Ex parte Rainu.

Regarding claims 1-3, the claim 7 of the Application No. 09/925,269 encompasses all the limitations of the instant application except the memory and logic of the mobile communication device as recited in the instant application. However, the memory and logic are inherently required in the each wireless transceiver of the Application No. 09/025, 269 to transmit the data packet

Regarding claim 4, the claim 7 of the Application No. 09/925,269 encompasses all the limitations of the instant application except low power for the radio frequency. It would have been obvious to one having ordinary skill in the art to incorporate low power to reduce interference.

Regarding claim 6, the claim 7 of the Application No. 09/925,269 encompasses all the limitations of the instant application except encryption. It would have been obvious to one having ordinary skill in the art incorporate encryption to provide security of the transmission.

Regarding claim 8, the claim 7 of the Application No. 09/925,269 encompasses all the limitations of the instant application except an acknowledgement of the signal. It

would have been obvious to one having ordinary skill in the art to incorporate a method of acknowledgement of signal to receive data correctly.

Regarding claims 9 and 10, the claim 7 of the Application No. 09/925,269 encompasses all the limitations of the instant application except that the wireless transceiver is integrated with a handheld computer or a wireless telephone. It would have been obvious to one having ordinary skill in the art to incorporate the wireless transceivers with a handheld computer or wireless telephone if no unexpected results can be seen from use of such computer or telephone.

Regarding claims 13, 14, and 16, the claim 12 of the Application No. 09/925,269 encompasses all the limitations except means for storing and means for retrieving as recited in the instant application. However, the means are inherently required for each wireless communication means of the Application No. 09/025, 269 to transmit the data packet.

Regarding claim 15, the claim 12 of the Application No. 09/925,269 encompasses all the limitations of the instant application except low power for the radio frequency. It would have been obvious to one having ordinary skill in the art to incorporate low power to reduce interference.

Regarding claim 17, the claim 12 of the Application No. 09/925,269 encompasses all the limitations of the instant application except encryption. It would have been obvious to one having ordinary skill in the art incorporate encryption to provide security of the transmission.

Regarding claim 19, the claim 7 of the Application No. 09/925,269 encompasses all the limitations of the instant application except an acknowledgement of the signal. It would have been obvious to one having ordinary skill in the art to incorporate a method of acknowledgement of signal to receive data correctly.

Regarding claims 20 and 21, the claim 12 of the Application No. 09/925,269 encompasses all the limitations of the instant application except that the wireless communication means are integrated with a handheld computer or a wireless telephone. It would have been obvious to one having ordinary skill in the art to incorporate the wireless transceivers with a handheld computer or wireless telephone if no unexpected results can be seen from use of such computer or telephone.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Allowable Subject Matter

5. Claims 22-24 would be allowable if the objection of claim 22 as discussed above is cleared.

Claims 7 and 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and the claim objection as discussed above is cleared.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Soon D. Hyun whose telephone number is 571-272-3121. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doris H. To can be reached on 571-272-7629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

S. Hyun
04/25/2006

KEVIN C. HARPER
PATENT EXAMINER